

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claims 15 and 16 are allowable and that claims 6, 7, 11, 12 and 55 contain allowable subject matter. In response, claims 6, 11 and 12 have been rewritten in independent form, including the limitations of base claim 1 and intervening claim 2 and claim 55 has been canceled. In including the limitations of base claim 1, the form thereof prior to the amendment of June 30, 2006 has been used since the indication of allowability was indicated prior to such amendment.

In the Official Action, the Examiner rejects claims 1-5, 8-10 and 54 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,071,279 to Whayne et al., (hereinafter "Whayne"). Additionally, the Examiner rejects claims 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Whayne in view of U.S. Patent No. 4,927,418 to Dake et al., (hereinafter "Dake").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(a) and 103(a) for at least the reasons set forth below. However, independent claim 1 has been amended to clarify its distinguishing features.

Specifically, claim 1 has been amended to clarify that the guide wire body has a distal end portion and a "proximal end portion terminating at a proximal end, the proximal end having a diameter substantially equal to a diameter of the proximal portion such that the proximal end can be inserted through a bore which is formed on an appliance and in which the guide wire is to be inserted." The amendment to claim 1 is fully disclosed in the original

disclosure. Thus, no new matter has been entered into the disclosure by way of the present amendment to claim 1.

In the embodiments disclosed in Whayne, the proximal end of the wire (106) is either attached to the distal end (104) of the sheath (102) or terminates in a stop (118) (see Figure 17A and column 14, lines 54-61). Both the attachment of the proximal end to the sheath and the stop prevents the wire (106) from being useful as a guidewire as such term is understood by those of ordinary skill in the medical arts and as is contemplated by the present application. As shown in Figure 1 of the present application, the appliance, such as a catheter (10), is inserted over a proximal end of the guidewire and guided towards the distal portion of the guidewire. Such a use is not possible or contemplated with the wire (106) disclosed by Whayne. Claim 1 has been amended as discussed above to clarify this distinguishing feature.

With regard to the rejection of claims 1-5, 8-10 and 54 under 35 U.S.C. § 102(a), a guide wire and endoscope having the features discussed above and as recited in independent claim 1, is nowhere disclosed in Whayne. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claim 1 is not anticipated by Whayne. Accordingly, independent claim 1 patentably distinguishes over Whayne and is allowable. Claims 2-5 and 8-10 being dependent upon claim 1 are thus at least allowable therewith (claim 54 being canceled). Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-5, 8-10 and 54 under 35 U.S.C. § 102(b).

With regard to the rejection of claims 13 and 14 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims

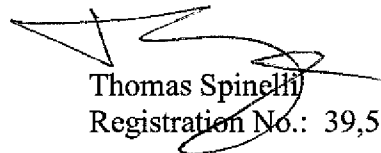
¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

13 and 14 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 13 and 14 under 35 U.S.C. § 103(a).

Lastly, the Examiner objects to claim 55 as being a substantial duplicate of claim 15. In response claim 55 has been canceled, thereby rendering the rejection thereof moot.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,


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